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Examiner: WALCZAK, David J.

Art Unit: 3751

Kurt L. Ehresman

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TOTAL NUMBER OF PAGES, INCLUDING THIS COVER LETTER: 5

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Altomey Docket No.: 13DV-14152 (07783-0136-01)

Application No.: 10/721,967 Filed: November 21, 2003

FAX NUMBER: (717) 237-5300

PARALEGAL RESPONSIBLE:

Kimberly A. Newell

TELEPHONE:

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TRANSMITTAL FORM (to be used for all correspondence after limited tiling)			Application Number	10/721,967			
			Filing Date	November 21, 2003			
			First Named Inventor	SKOOG et al.			
			Art Unit	3751			
			Examiner Namo	WALCZAK, David J.			
Total Number of Pages in This Submission 5			Attorney Docket Number	13DV-14152 (07783-0136-01)			
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· Fee Attached		Licensing-related Papers		Appeal Communication to Board of Appeals and Interferences			
Amendment / Reply		Polition		Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)			
After Final		Petition to Convert to a Provisional Application		Propriet	ary Information		
Affidavits/declaration(s)		Power of Attorney, Revocation Change of Correspondence Address		Status L	otter		
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Response to Missing Parts/ Incomplete Application							
Response to Missing Parts under 37 CFR 1.52 or 1.53							
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT							
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Date June 22, 2005							
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Typed or printed nam	Typed or printed name Kimberly A. Newell						
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Application No.: 10/721, 967

Alexandria, VA 22313-1450

Attorney Docket No.: 13DV-14152 (07783-0136-01)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant of:	SKOOG et al.	Group Art Unit:	3751
Application No.:	10/721,967	Examiner: WALC	CZAK, David J.
Filed:	November 21, 2003)	Atty. Docket No.	13DV-14152 (07783-0136-01)
For: APPARATUS COATED SU	S AND METHODS FOR C JRFACES	LEANING AND PR	
Mail Stop AMENDN Commissioner for F P.O. Box 1450			

RESPONSE UNDER 37 C.F.R. 1.111

Sir:

Applicant responds to the Office Action of June 6, 2005, which sets forth a restriction requirement. The statement of the restriction places claims 1-14 into article Group I and claims 15-21 into method Group II.

Applicant hereby elects to prosecute the method claims of Group II, with traverse. The basis of the traverse is as follows. The restriction is made pursuant to 35 USC 121. The claims must be shown to be "independent <u>and</u> distinct" to maintain the restriction, 35 USC 121, 37 CFR 1.142, MPEP 802. Since this requirement is statutory, it is not proper to interpret the statute in any other fashion.

The restriction asserts that the inventions are "distinct", but does not address the question of whether the inventions of Groups I and II are "independent", as required by the statute, the regulations, and the MPEP. Applicant submits that the inventions of Groups I and II are not "independent". The term "independent" is defined in MPEP 802.01:

"The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect . . ."

Application No.: 10/721, 967

Attorney Docket No.: 13DV-14152 (07783-0136-01)

- 2 -

The restriction can be made only "If it can be shown that the two or more inventions are in fact independent . . .", MPEP 806.04. As made quite clear in the specification, the subject matter of Groups 1 and II are not "independent". Specifically, the disclosed relationship is that the apparatus of Group I is used in practicing the methods of Group II.

The Examiner has set forth a secondary restriction within Group I, asserting that Figure 1 and Figure 2 are "patentably distinct species." In response, and only in the case that the Examiner withdraws the primary restriction between Group I and Group II and maintains the secondary restriction between Figure 1 and Figure 2, Applicant then provisionally elects, with traverse, Species I for prosecution. Applicant notes that claims 1-10 are directed to the embodiment of Figure 1, and that claims 11-14 are directed to Figure 2.

In sum, Applicant elects Group II, with traverse. Applicant maintains that the inventions of Group I and Group II are not "independent and distinct", and that no undue burden on the Examiner would result from search of both Group I and Group II. The claims should therefore be examined in the same application, pursuant to the various statutes, regulations, and MPEP sections set forth herein. Applicant asks that the Examiner reconsider and withdraw the restriction requirement as to Groups I and II.

Respectfully submitted.

Dated: June 22, 2005

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PTO/59/97 (08/03)

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Attorney Docket No.: 13DV-14152 (07783-0136-01).

Application No.: 10/721,967 Filed: November 21, 2003

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